

REMARKS

In reply to the Office Action dated February 4, 2004, Applicant has cancelled claims 16-61, without prejudice or disclaimer of the non-elected subject matter therein, amended claims 1, 3, and 6 to clarify the claimed invention, and added new claims 62-96 to protect additional aspects of the elected invention. Each of the newly added claims read on the elected invention. As a result of this Amendment, claims 1-15 and 62-96 are currently pending.

As discussed on pages 3-4 of the Office Action, the Examiner rejected claims 1 and 2 under 35 U.S.C. § 102(e) as being anticipated by Odom et al. (U.S. Patent No. 6,058,379). Moreover, the Examiner rejected claims 3-15 under 35 U.S.C. § 103(a) as being unpatentable over Odom et al., according to the rationale discussed on pages 4-7.

Odom et al., however, fails to render the claimed invention unpatentable. Each of the claims recite different combinations of features that distinguish the invention from the prior art. For example, independent claim 1 recites a combination that includes, among other things,

randomly generating an offer to purchase a product or service on the electronic network system; [and]

communicating the randomly generated offer through the electronic network system at an unknown start time and for a predetermined duration of time to one or more potential buyers connected to the electronic network system,

(amended claim 1, ll. 1-13). Independent claim 62 recites another combination that includes, for example,

randomly displaying at least one offer to accept a product or service to a one or more potential recipients on the electronic network system at an unknown start time;

providing an opportunity for the one or more potential recipients on the electronic network system to accept the at least one randomly displayed offer within a limited duration of time;

receiving an indication of acceptance of the randomly displayed offer from the one or more potential recipients on the electronic network system;

completing the sale of the product or service through the electronic network system in response to an acceptance of the offer by the one or more potential recipients on the electronic network system; and

removing the offer from the electronic network system should the one or more potential recipients not accept the offer within the limited duration of time,

(new claim 62, ll. 1-15). Independent claim 83 recites yet another combination that includes, *inter alia*,

providing a random frequency device for randomly displaying an offer to one or more potential recipients on the electronic network system to accept a discounted product or service at a price substantially equal to the delivery price of the product or service, the randomly displayed offer having an unpredictable start time,

(new claim 83, ll. 1-18). Finally, independent claim 90 recites a combination of that includes, for instance,

a step for randomly displaying an offer to one or more potential recipients on the electronic network system to accept a discounted product or service at a price substantially equal to the delivery price of the product or service, the randomly displayed offer having an unpredictable start time,

(new claim 90, ll. 1-17). At the very least, Odom et al. fails to disclose or suggest any of these exemplary features recited in the independent claims.

To establish anticipation under 35 U.S.C. § 102(e), the Examiner must show that each and every feature recited in these claims is either explicitly disclosed or “necessarily present” in a single prior art reference, such as within the four corners of the Odom et al. patent. See M.P.E.P. § 2131 (7th ed. 1998); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269

(Fed. Cir. 1991). Moreover, to make out a *prima facie* case of obviousness, the Examiner must demonstrate (1) that Odom et al., as proposed to be modified by the Examiner, discloses or suggests each and every feature recited in the claim, (2) that there is a reasonable probability of success of such modifications, and (3) the existence of some suggestion or motivation, either in the Odom et al. patent itself or in the knowledge generally available to one of ordinary skill in the art, to make such modification so as to result in the claimed invention. See M.P.E.P. § 2143 (7th ed. 1998). It bears emphasizing that each of these requirements must be found in the prior art — not based on Applicant's own disclosure. See *id.*

Viewed against this backdrop, each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1432 (Fed. Cir 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Odom et al., taken alone or in combination with any other prior art reference, can either anticipate or render obvious each and every one of the limitations present in the independent claims, as required by the Manual of Patent Examining Procedure ("MPEP") and Federal Circuit jurisprudence.

Odom et al. discloses a real-time network exchange with seller specified exchange parameters and interactive seller participation. See Abstract. Odom et al.,

however, fails to provide any disclosure whatsoever of either “randomly generating an offer to purchase a product or service on an electronic network system,” or “communicating the randomly generated offer through the electronic network system at an unknown start time . . . to one or more potential buyers connected to the electronic network system,” as stated in independent claim 1. Similarly, Odom et al. fails to provide any disclosure of the random display features recited in independent claims 62, 83, and 90. Instead, Odom et al. teaches away from the claimed invention by necessarily specifying the start time for a sale offer on an electronic exchange between a seller and a potential buyer. For instance, Odom et al. specifically discloses a system that

enables the capability to operate an exchange that is based on at least an eight-step capability. In step one, the mode of operation of the exchange is specified. In this step, parameters such as the start/stop time for the exchange, the exchange’s open or closed status, public or private access to negotiations, seller information, bid requirements, etc. may be specified. This may be done by the seller and/or auction host. Next, the proposed exchange item can be further identified. This information may include entering information about the item to be sold, which may include its classification, pricing information, etc. Next, the proposed item is added to an electronic listing. This may include posting the information on a world wide web page,

Col. 3, ll. 13-26 (emphasis added). By contrast, independent claims 1, 62, 83, and 90 call for an offer for sale on an electronic network system that is random, or, by definition, unpredictable. These features are neither explicitly stated, nor necessarily present within the Odom et al. patent disclosure, as required by 35 U.S.C. § 102. Accordingly, Odom et al. cannot anticipate independent claims 1, 62, 83, and 90.

With respect to dependent claims 3-15, the Examiner has failed to establish a *prima facie* case of obviousness. In fact, in conceding that the Odom

et al. patent fails to disclose or suggest a variety of claim features, the Examiner appears to take Official Notice of these claim features. For example, the Examiner states that

Official notice is taken that the step of providing a random frequency device for displaying random offers is old and well known in the art. These devices like pop-up ads generate offers that sometimes results in a sale. This helps the seller increase his/her potential sales without requiring the seller intervention,

(Office Action at 5; see *also* Office Action at 7). However, Official Notice cannot be applied to such a wide variety of features, which are neither notoriously old, nor well known to one of ordinary skill at the time of the invention. The Examiner's rationale is not based solely on facts that are "capable of instant and unquestionable demonstration as being 'well-known' in the art." M.P.E.P. § 2144.03 (7th ed. 1998). According to the MPEP, when a rejection is based on facts within the Examiner's personal knowledge, the data used to support that rejection should at least be stated as specifically as possible. See *id.* Instead of doing so, the Examiner provided a classic example of an impermissible hindsight reconstruction of Applicant's own disclosure as a basis to reject the dependent claims 3-16 under 35 U.S.C. § 103(a). As a result, Applicant has been unfairly denied the opportunity to either address the true merits of the prior art or receive a Notice of Allowance without undue delay. Applicant thus challenges the Examiner's use of his own uncorroborated personal knowledge as a substitute for issuing a complete Office Action on the merits, and requests appropriate identification in the form of a competent prior art reference and corroboration of the Examiner's grounds for invoking Official Notice in the form of a non-final Office Action. In lieu of such a complete Office Action on the merits, Applicant respectfully requests that the Examiner

withdraw the outstanding grounds for rejection and place this application in condition for allowance.

Moreover, even if Odom et al. could be properly modified to result in the claimed invention, which it could not, there is no motivation for modifying this reference in the manner suggested by the Examiner. One having ordinary skill in the art at the time of the invention would not even consider making the Examiner's imagined modification (i.e., replacing Odom et al.'s system for specifying the start time of sale offers with the Applicant's method for randomly offering a produce or service) because Odom et al. explicitly teaches away from this alteration, as discussed above. Indeed, the Examiner's fictitious changes would impermissibly: (1) render Odom et al. unsatisfactory for its intended purposes; and (2) change the principles of operation of the Odom et al. system. By way of further example, since Odom et al. teaches that the start time of sale offers is specified "by the seller and/or auction host," col. 3, l. 20, modifying the structure and operation of the Odom et al. system with method for randomly generating sale offers would amount to a superfluous and unintended exercise. The MPEP specifically states that if the "proposed modification would render the prior art unsatisfactory for its intended purpose" or "change a principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. § 2143.01 at 112-13 (7th ed. 1998). Accordingly, it is only through hindsight afforded by Applicant's own disclosure that the Examiner can even assert that the applied references suggest the claimed invention. Such hindsight determinations are impermissible under 35 U.S.C. § 103.

For at least these reasons, Odom et al. fails to disclose or render obvious each and every element recited in the independent claims. In addition, claims 2-15, 63-82, 84-89, and 91-96, which all depend upon one of the independent claims, respectively, recite additional features that are neither disclosed nor suggested by each of the applied references, taken either alone or in combination. Thus, each of the dependent claims are allowable for at least the same reasons discussed above with respect to the independent claims 1, 62, 83, and 90.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of all the pending claims 1-15 and 62-96. Should it be necessary to resolve any additional concerns and expedite the issuance of a Notice of Allowance, the Examiner is invited to contact Applicant's representative at (202) 408-6052.

Please grant any extension of time to the extent required to enter this response and charge any fees required to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 6, 2004

By: 

Christopher W. Day
Reg. No. 43,944